

REMARKS**Summary of the Office Action**

Claim 31 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6, 27-29, and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,380,047 to Molee et al. (“Molee”) in view of U.S. Patent No. 5,116,548 to Mallik et al. (“Mallik”).

Claims 6 and 27-31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,921,352 to Adolfs et al. (“Adolfs”) in view of Mallik.

Claims 6, 27-29, and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,889,366 to Fabbiani (“Fabbiani”) in view of U.S. Patent No. 5,843,598 to Ueda et al. (“Ueda ’598”).

Claims 6 and 27-31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fabbiani in view of Ueda ’598, U.S. Patent No. 6,127,066 to Ueda (“Ueda ’066”), and Adolfs.

Summary of the Response to the Office Action

Applicant has amended claims 27 and 31.

All Claims Define Allowable Subject Matter

Claims 6, 27-29, and 31 are rejected under 35 U.S.C. § 103(a) as being anticipated by Molee in view of Mallik. Rather than disclosing “a plurality of sub-holograms formed in the hologram recording tape,” Molee discloses “a unique product code number ... imprinted on the hologram in a conventional manner.” (Molee at col. 2, lines 14-17; emphasis added; see also Fig. 2 and col. 2, lines 23-44). There is also no mention in Molee of the hologram recording tape comprising a photo-polymer.

Mallik discloses a method and system for producing replicas of holograms using a hologram master and that the hologram is a relief hologram. Even if it is assumed that the identification numbers disclosed by Molee are recorded by a hologram, combination of Molee and the replication method of Mallik would not result in the present invention. This combination would result in a method of producing large numbers of replicas of a hologram and a pattern produced in a conventional manner rather than reproductions of a main hologram of the same pattern with a sub-hologram of a different pattern for each reproduction as done by the present invention. Applicant respectfully requests that the rejections under 35 U.S.C. § 103(a) based on the combination of Molee and Mallik of claims 6, 27-29, and 31 be withdrawn.

Claims 6 and 27-31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Adolfi in view of Mallik. Adolfi discloses a contactless method of using holography to determine characteristics of an object. There is no indication that there is a different sub-hologram formed on replicas of the same main-hologram as required by the claims of present

application. As explained above, Molee simply discloses a unique identification number printed on a hologram in a conventional manner. Combining Adolfs and Mallik would not produce the present invention, which is a hologram recording tape comprising a plurality of main holograms, each main hologram being substantially the same, and a plurality of sub-holograms being formed in the hologram recording tape, each of the plurality of sub-holograms being disposed adjacent one of the plurality of main holograms and being different from all others of the plurality of the sub-holograms. Applicant respectfully requests that the rejections under 35 U.S.C. § 103(a) based on the combination of Adolfs and Mallik of claims 6 and 27-31 be withdrawn.

Claims 6, 27-29, and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fabbiani in view of Ueda '598. Fabbiani teaches with respect to Fig. 1(b) the formation of a hologram which includes an image (7), barcoding (23), and a number (24) – all recorded holographically. Ueda '598 mentions reproduction of a hologram with respect to Fig. 8. The combination of Fabbiani and Ueda '598 only results in a method of reproducing a hologram in large quantities rather than the present invention, which is a hologram recording tape comprising a plurality of main holograms, each main hologram being substantially the same, and a plurality of sub-holograms being formed in the hologram recording tape, each of the plurality of sub-holograms being disposed adjacent one of the plurality of main holograms and being different from all others of the plurality of the sub-holograms. Applicant respectfully requests that the rejections of claims 6, 27-29, and 31 under 35 U.S.C. § 103(a) based on the combination of Fabbiani and Ueda '598 be withdrawn.

Claims 6 and 27-31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fabbiani in view of Ueda '598, Ueda '066, and Adolfs. Ueda '066 discloses a hologram recording sheet and a reproduction process of using the sheet that provides nothing to remedy the deficiencies explained above with regard to the rejection under 35 U.S.C. § 103(a) as being unpatentable over Fabbiani in view of Ueda '598. Similarly, as explained above, Adolfs discloses a contactless method of using holography to determine characteristics of an object, with no indication that there is a different sub-hologram formed on replicas of the same main-hologram as required by the claims of present application. Applicant respectfully requests that the rejection under 35 U.S.C. § 103(a) based on the combination of Fabbiani, Ueda '598, Ueda '066, and Adolfs be withdrawn.

Assuming, for the sake of argument that any combination of references cited by the Examiner would produce the present invention, Applicant submits that there is no motivation to combine any of the references cited by the Examiner. MPEP § 2143.01 instructs that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)." MPEP § 2143.01 further instructs that "[a]lthough a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.'" Applicant respectfully submits that the references do not provide such a suggestion or motivation.

Applicant respectfully submits that the only motivation to piece together any references of the Office Action is found in the Applicant's own application. MPEP § 2141 instructs that "the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention." MPEP 2143 instructs that "the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ 1438 (Fed. Cir. 1991)." The Federal Circuit has clearly held that "the motivation to combine references cannot come from the invention itself." Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc., 21 F.3d 1068, 30 USPQ 2d 1377 (Fed. Cir. 1993).

Thus, Applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness and that the rejection of claims 6, 27-29, and 31 under 35 U.S.C. § 103(a) using the combination of Molee and Mallik; the rejection of claims 6 and 27-31 under 35 U.S.C. § 103(a) using the combination of Adolfs and Mallik; the rejection of claims 6, 27-29, and 31 under 35 U.S.C. § 103(a) using the combination of Fabbiani and Ueda '598; and the rejection of claims 6 and 27-31 using the combination of Fabbiani, Ueda '598, Ueda '066, and Adolfs should be withdrawn.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

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By: Kent Basson
Kent Basson
Reg. No. 48,125

Customer No.: 009629

MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Tel. 202.739.3000
Fax. 202.739.3001